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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,416

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LSP-1016US

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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

07/01/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@mktlaw.us.com

Office Action Summary	Application No. 10/560,416	Applicant(s) BENETTI ET AL.	
	Examiner MELISSA S. MERCIER	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22, 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

Receipt of Applicants Remarks and Amended Claims filed on April 21, 2010 is acknowledged. Claims 17-22 and claim 30 remain pending in this application and are under prosecution.

Withdrawn Rejections/Objections

Claim Rejections - 35 USC § 112

The rejections of claims 17-22 and 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in view of Applicants arguments and clarification of the claim language and the wherein clause of the independent claim.

The rejection of claims 17-22 and 30 under 35 U.S.C. 103(a) as being unpatentable over Yeung et al. (US Patent 5,721,313) in view of Fillipo et al. (US Patent 5,169,540) has been withdrawn in view of Applicants arguments regarding the percentage of the

Maintained Rejections/Objections

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "strongly acidic" is a relative term which renders the claim indefinite. The term "strongly acidic" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what is considered to be strongly acidic and what is not as no point of reference is cited.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues:

""strongly acidic" and "strong acid" have well recognized meaning in chemistry, is acknowledged.

The Examiner respectfully disagrees. The terms "strongly acidic" and "strong acid" are not considered synonymous because "strongly acidic" is used as functional language to describe a synthetic organic polymer constituent. A "strong acid," as applicant has pointed out, is an acid for which essentially all the acid molecules dissociate in solution. A person having ordinary skill in the basic chemical arts would consider the most common "strong acids" as inorganic acids such as sulfuric acid, hydrochloric acid, or nitric acid, inter alia. It is unclear whether applicant intends to include such acids in the scope of the claimed "strongly acidic" functional group. And

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while applicant has gone to great length to clarify in their arguments what exactly the term "strongly acidic" means, the metes and bounds of the claim remain indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 17-22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung et al. (US Patent 5,721,313) in view of Fillipo et al. (US Patent 5,169,540).

Yeung discloses polymer emulsions formed by inverse polymerization reactions. The polymer is a reaction product of:

(a) an ethylenically unsaturated carboxylate having between about 3 and about 6 carbon atoms;

(b) an ethylenically unsaturated monomer which is nonionic in nature;

(c) an ethylenically unsaturated monomer containing one or more sulfonate or sulfoalkyl groups;

(d) an ethylenically unsaturated monomer having surface active properties; and

(e) a crosslinking agent is provided;

wherein:

(a) can be acrylic acid or methacrylic acid in the amount of 50-90% of the polymer solids;

(c) can be 2-acrylamido-2-methylpropanesulfonic acid (AMPS) in the amount of 1-20%, and

(e) can be methylenebisacrylamide in the amount of 0.01-5.0%.

The polymer composition can be utilized in a cosmetic composition (column 1, lines 60-64). The polymer composition typically comprises from 1-70% by weight of the final composition (column 2, lines 20-25).

The emulsions are water in oil emulsions (abstract). The oil phase can comprise hydrocarbon solvents, such as mineral oils (column 4, lines 13-30). The examples

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disclose the preparation of numerous emulsions obtained with varying amounts of each component utilized.

Yeung does not disclose the use of a cationic acrylic monomer.

Fillipo disclose inverse emulsions comprising cationic monomers commonly copolymerized with acrylamide including acryloyloxyethyltrimethylammonium chloride and methacryloyloxyethyltrimethylammonium chloride (column 4), which are the polymers recited in the instant claims.

Applicant is reminded that where the general conditions of the claims are met, burden is shifted to applicant to provide a patentable distinction. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Aller*, 220 F.2d 454 105 USPQ 233,235 (CCPA 1955).

Based on the advantages of the components disclosed by the Yeung and Fillipo, the skilled artisan would have a reasonable expectation of success in preparing an inverse emulsion containing a cationic polymer as disclosed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the cationic polymers of Fillipo since it is disclosed the cationic monomers which are commonly copolymerized with acrylamide including acryloyloxyethyltrimethylammonium chloride and methacryloyloxyethyltrimethylammonium chloride provide stable blends in aqueous emulsions and can be used in lower amounts than what was previously used.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Applicant has argued that the percentage of each component is relative to the weight of the emulsion as a whole, whereas the Yeung reference discloses the percentages based on the polymeric portion of the emulsions and not the emulsions as a whole. Therefore, the percentages can not be compared as Applicant has in the remarks filed on April 21, 2010.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/Carlos A. Azpuru/
Primary Examiner, Art Unit 1615